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EXAMINER	
MADAMBA, GLENFORD J	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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In re Application of: Rikin S. Patel
Application No. **10/729,607**
Filed: December 5, 2003
Atty Docket No. 200901531-1
Title of Invention: SYSTEM AND METHOD FOR FAULT MANAGEMENT IN A SERVICE-ORIENTED ARCHITECTURE

DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on the petition filed August 03, 2008 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner and require the Examiner to designate Examiner's Answer mailed 06/04/09 as new grounds of rejection over Hsu et. al., Cantania et. al, and Russell et. al.

The Applicant's counsel filed a petition to the Director under 37 CFR § 1.181 to seek relief from actions of the Examiner in relation to Examiner's Answer as improperly applying a new reference (Russell et. al.), and as such is hereby requesting that the ground set forth in the Examiner's Answer be designated as new ground of rejection over Hsu et. al., Cantania et. al, and Russell et. al.

The petition is **DISMISSED**.

RELEVANT PROSECUTION HISTORY

08/07/07 Non-final action was issued. Claims 1, 3-13, 16-29 and 29-44 were rejected under 35 USC 102(e) as being anticipated by HSU et. al. Further claims 2, 14-15, 27-28 and 45 were rejected under 35 USC 103(a) as being unpatentable over HSU et. al. in view of CATANIA et. al.

10/26/07 Amendment/Reply under 37 CFR §1.111 was filed. Claims were amendment, namely, claims 2-3, 6, 11 and 26 were **amended** and claims 1, 13-14 were canceled. Basic argument were the applied reference(s) do not claim added limitations to independent claims 11 and 26, also present in claim 2.

01/28/08 Final action was issued. Claims 2-12, 15-26 and 29-44 were rejected under 35 USC 103(a) as being unpatentable over HSU et. al. in view of AGARWAL et. al.

Further claims 27-28 and 45 were rejected under 35 USC 103(a) as being unpatentable over HSU et. al. in view of AGARWAL et. al. in further view of CATANIA et. al. The AGARWAL et. al. references appears to be introduced in the rejection of at least claims 2-12, 15-26 and 29-44 to teach claim limitation "translating the service request into a non-web service language" (see p. 3).

03/11/08 After-Final Amendment/Reply was filed. No amendments to the claims were filed. Claims 2-12, and 15-45 pending. Applicant requested finality of office action mailed 01/28/08 withdrawn.

Reason being independent **claim 45 not amended** was rejected under new grounds, namely, rejected under 35 USC 103(a) as being unpatentable over HSU et. al. in view of AGARWAL et. al. in further view of CATANIA et. al.

Furthermore, claim 2 was only amended (according to applicant) by **rewriting claim 2 in independent form** (i.e. incorporating the features of claim 1). Thus, the amendment to claim 2 did not change the scope of claim 2

05/16/08 Final action was issued. Examiner's remarks (p. 2) indicate that: "Applicant's remarks and arguments concerning the finality of the rejected claims under 103(a) grounds of rejection as being obvious over Hsu in view of Agarwal and in further view of Catania have been considered and **deemed persuasive**. Thus, the finality of the rejected claims under Hsu in view of Agarwal and Catania of the previous action is ***withdrawn***, and the following grounds of rejection is accordingly provided for the present claims." Claims 2-12 and 15-45 were rejected under 35 USC 103(a) as being unpatentable over HSU et. al. in view of CATANIA et. al. Final office action stated the rejection was made file by applicant's amendment (p. 14).

In this rejection the **AGARWAL et. al. reference was removed**, and thus claims 2-12, 15-45 were rejected under HSU et. al. in view of CATANIA et. al. The later reference was relied upon in rejecting at least claims 2-12, 15-26 and 29-44, to teach claim limitation "translating the service request into a non-web service language" (see p. 3).

08/12/08 Notice of Appeal was filed.

08/12/08 Pre-Brief Appeal Conference was requested.

10/23/08 Pre-Brief Appeal Conference decision was mailed. Decision indicated Proceed to the Board of Patent Appeals and Interferences.

02/23/09 Appeal Brief is filed.

03/23/09 Non-compliant Appeal Brief is filed. The Brief does no contain a statement of the status of all claims (e.g. rejected, allowed, withdrawn, objected to, canceled) or does not identify the appealed claims (37 CFR 41.37(c) (1)(iii).

04/22/09 Corrected Appeal Brief was filed.

06/04/09 Examiner's Answer to Appeal Brief was mailed. In the Response to Argument section (10) of the Answer (p. 21), examiner states:

> As support for this position, the Office provides supplemental / evidentiary prior art to *Russell* et al - cited but not referred to - which expressly details the well-known feature of converting or 'translating' request / response messages from a 'web services' format to a 'non-web services' format - and vice versa - through serialization or deserialization of a message object (e.g., 'Java Bean') for application to web services [0004-0006] [0019-0020] [0040-0048] [Figs. 2,5,6 &10].

Grounds of rejection set for in Examiner's Answer include: Claims 2-12 and 15-45 rejected under 35 U.S.C. 103(a) as being unpatentable over HSU et. al. in view of CATANIA et. al.

STATUTES, RULES AND PROCEDURES

MPEP 1207.03 [R-3] New Ground of Rejection in Examiner's Answer

37 CFR 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. New grounds of rejection in an examiner's answer are envisioned to be rare, rather than a routine occurrence. For example, where appellant made a new argument for the first time in the appeal brief, the examiner may include a new ground of rejection in an examiner's answer to address the newly presented argument by adding a secondary reference from the prior art on the record.

New grounds of rejection are not limited to only a rejection made in response to an argument presented for the first time in an appeal brief. At the time of preparing the answer to an appeal brief, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the answer.

The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP §1002.02(d) and § 1207.04. A supplemental examiner's answer cannot include a new ground of rejection, except when a supplemental answer is written in response to a remand by the Board for further consideration of a rejection under 37 CFR 41.50(a). See MPEP § 1207.05.

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection

remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. At 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

Where the statutory ***basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same***, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). Where a newly cited reference is added merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new ground of rejection within the meaning of 37 CFR 41.39(a)(2). See also MPEP § 2144.03.

If the TC Director or designee decides that the rejection is considered a new ground of rejection and approves the new ground of rejection, the examiner would be required to send a corrected examiner's answer that identifies the rejection as a new ground of rejection and includes the approval of the TC Director or designee. The appellant may then file either a request that prosecution be reopened by filing a reply under 37 CFR §1.111, or a request that the appeal be maintained by filing a reply brief or resubmitting the previously-filed reply brief, within two months from the mailing of the corrected answer.

If the TC Director or designee agrees with the examiner that the rejection is not a new ground of rejection, ***the examiner would not be required to send a corrected examiner's answer.***

OPINION

The prosecution history of instant application has been carefully reviewed.

The facts are: The RUSSELL et. al. was listed as prior art of record and not relied upon and considered pertinent to applicant's disclosure on office action mailed 08/07/07 and further made of record, i.e. thereby cited on PTO-892 08/07/07.

Further the RUSSELL et. al. reference was not relied upon as the basis of rejection for any pending claims 2-12 and 15-45 in the Examiner's Answer to Appeal Brief mailed 06/04/09.

This reference is made reference to in the Response to Argument section (10) of Examiner's Answer as "supplemental / evidentiary prior art".

Thus, the RUSSELL et. al. is ***not*** a new prior art reference *applied or cited* for the first time in an examiner's answer and was not used to support a rejection (not even in minor capacity), hence, would not have to be included in the statement of rejection.

However, Examiner's Answer to the Appeal Brief on Section (8) Evidence Relied Upon lists US 2004/0039964 RUSSELL et. al., as a reference under this ***sub-heading***.

It will be left to the Board of Appeals and Interference to determine whether the including of this reference under said sub-headings are sufficient grounds for a remand to the Examiner.

For the reasons stated above, this petition is **Dismissed**.

The Examiner's Answer will be forwarded to the Board of Patent Appeals and Interferences.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-3902. If attempts to reach the undersigned by telephone are unsuccessful, Kim Huynh, Quality Assurance Specialist, can be reached at (571) 272-4147.

/bp/

/Beatriz Prieto/

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